

Remarks

These Remarks are in reply to the Office action mailed October 21, 2004. Claims 1-5 and 7-17 are presented herewith for consideration.

I. Summary of the Examiner's Objections

Claims 1- 6 were rejected under 35 U.S.C. §102(e) as being anticipated by U. S. Patent No. 6,295,541 (Bodnar et al.).

Claims 1-5, 7-17 were rejected under the judicially created doctrine of double patenting as being patentable over claims 1-30 of U.S. Patent No. 6,295,541.

II. Remarks

Rejection of Claims 1-6 Under 35 U.S.C. §102(e)

Claims 1- 6 were rejected under 35 U.S.C. §102(e) as being anticipated by U. S. Patent No. 6,295,541 (Bodnar et al.). Bodnar et al. is only a reference under 35 U.S.C. §102(e). Applicant submits herewith two declarations under 37 C.F.R §1.131 swearing behind the Bodnar et al. reference.

It is respectfully submitted that the Declarations are proper as showing evidence of conception well prior to December 16, 1997, the earliest priority date of Bodnar et al., as well as diligence in reducing the invention to practice after conception.

Bodnar et al. issued on September 25, 2001, after the filing date of the present application and is therefore only available as a reference under 35 USC §102(e). Bodnar et al. was filed August 18, 1998, but claims priority to provisional applications Ser. No. 60/069,731, filed Dec. 16, 1997, and entitled DATA PROCESSING ENVIRONMENT WITH SYNCHRONIZATION METHODS EMPLOYING A UNIFICATION DATABASE; Ser. No. 60/094,972, filed Jul. 31, 1998, and entitled SYSTEM AND METHODS FOR SYNCHRONIZING TWO OR MORE DATASETS; and Ser. No. 60/094,824, filed Jul. 31, 1998, and entitled DATA PROCESSING ENVIRONMENT WITH METHODS PROVIDING CONTEMPORANEOUS SYNCHRONIZATION OF TWO OR MORE CLIENTS. As noted in the MPEP SECTION 706.02:

A rejection based on 35 U.S.C. 102(e) can be overcome by:

(D) Filing an affidavit or declaration under 37 CFR 1.131 showing prior invention, if the reference is not a U.S. patent (or application in the case of a provisional rejection) claiming the same patentable invention as defined in 37 CFR 1.601(n).

A Section 1.131 affidavit is proper in this instance because Bodnar et al. claims methods and systems directed to “an arbitrary number of multiple datasets residing on different devices”, “a reference dataset that is used to store a super-set of most-recent data from all of the designated datasets” and “synchronizing all of the designated datasets”, while the present application is directed to “a data package containing instructions for manipulating user data” and “code for instructing a software agent to alter data in a data structure”.

Hence Bodnar et al. and the present application do not claim the same invention.

Submitted herewith are the Declaration Of Richard M. Onyon Pursuant To 37 C.F.R. §1.131 and Declaration Of Leighton Ridgard Pursuant To 37 C.F.R. §1.131, each setting forth facts establishing a date of invention prior to the priority date of December 16, 1997.

It is respectfully submitted that these declarations under 37 C.F.R. §1.131 set forth facts showing possession of the invention sufficient to overcome Bodnar et al. as a reference.

As set forth in the attached Declarations of Mr. Onyon and Mr. Ridgard, the invention recited in the claims of the present invention was conceived of earlier than the earliest possible date of Bodnar et al. as a prior art reference, and the inventors were diligent from the date of conception to the reduction to practice of the invention (as evidenced by prototypes of the invention). It is therefore respectfully submitted that the rejection of the claims over Bodnar et al. is overcome and it is respectfully requested that the rejection over Bodnar et al. be withdrawn.

It is noted that the attached Declarations of Mr. Onyon and Mr. Ridgard are copies of declarations submitted on July 16, 2003, in response to the Office action dated March 12, 2003. On March 12, 2003, the Examiner rejected Claims 1-6 over Bodnar et al. In response to the Office action, applicants filed a Response A to Office Action on July 16, 2003, adding Claims 7-17, and also submitting the above-identified Declarations showing that the invention recited in Claims 1-5 and 7-17 was invented earlier than Bodnar et al. (Claim 6 was canceled). In response to the July 16, 2003 Response A to Office Action, the Examiner accepted applicants' Declarations as showing the

claimed invention was invented earlier than Bodnar et al., and the Examiner withdrew the rejection over Bodnar et al.

The claims as presently set forth in the application are identical to the claims set forth in the July 16, 2003 Response A to Office Action. Therefore, it is respectfully submitted that the attached Declarations remain effective in showing the claimed invention was invented earlier than Bodnar et al. It is therefore respectfully requested that the rejection on these grounds be withdrawn.

Double Patenting Rejection of Claims 1-5 and 7-17

Claims 1-5 and 7-17 were rejected under the judicially created doctrine of double patenting as being patentable over claims 1-30 of U.S. Patent No. 6,295,541 ("the '541 Patent"). Applicants respectfully traverse the rejection on the ground that the present application and the '541 Patent are not from a common inventive entity.

Double patenting rejections exist to prevent an inventive entity from obtaining more than one valid patent for the same invention, or an obvious modification of the same invention. Therefore, when two inventions are by two different inventive entities, the question of double patenting does not arise and is improper. As set forth in MPEP §804, "Before consideration can be given to the issue of double patenting, there must be some common relationship of inventorship and/or ownership of two or more patents or applications. See also, *In re Longi*, 759 F.2d 887 (Fed. Cir. 1985).

The inventors of the '541 Patent are:

Eric Bodnar
Chris LaRue
Bryan Dube
Shekhar Kirani
Sethuraman Suresh

The inventors of the present invention are:

David Multer
Robert Garner
Leighton Ridgard
Liam Stannard
Donald Cash
Scott Klein
Richard Onyon

Thus, none of the inventors on the '541 Patent and the present invention are the same.

The '541 Patent is listed as being assigned to Starfish Software, Inc., having offices in Scotts Valley, California. The present invention is assigned to fusionOne, Inc., having offices in San Jose California. Thus, the inventions are not assigned to the same corporate entity.

Based on the above, the '541 Patent and the present invention are not by the same inventive entity, and as such, a double patenting rejection is not applicable. Applicants respectfully request that the rejection of the claims on these grounds be withdrawn.

Based on the above amendments and these remarks, reconsideration of claims 1-5 and 7 - 17 is respectfully requested.

The Examiner's prompt attention to this matter is greatly appreciated. Should further questions remain, the Examiner is invited to contact the undersigned attorney by telephone.

The Commissioner is authorized to charge any underpayment or credit any overpayment to Deposit Account No. 501826 for any matter in connection with this response, including any fee for extension of time, which may be required.

Respectfully submitted,

Date: April 21, 2005

By: 

Brian I. Marcus
Reg. No. 34,511

VIERRA MAGEN MARCUS HARMON & DENIRO LLP
685 Market Street, Suite 540
San Francisco, CA 94105-4206
Telephone: (415) 369-9660
Facsimile: (415) 369-9665